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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,857	09/23/2005	Claudio Zampieri	2005_1196A	4778

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WENDEROTH, LIND & PONACK, L.L.P.
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SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

COLLADO, CYNTHIA FRANCISCA

ART UNIT	PAPER NUMBER
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3618

MAIL DATE	DELIVERY MODE
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11/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,857

Applicant(s)

ZAMPIERI, CLAUDIO

Examiner

CYNTHIA F. COLLADO

Art Unit

3618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) 1-4 and 6 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5 and 7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borel (US Patent No 2001/0013695) in view of Hilgarth (US Patent No.6, 015,157). Regarding claim 5, Borel discloses a footwear having a sole on the bottom thereof, the sole having a heel-piece zone (fig 4, element 26) and a toe juncture area corresponding to an area of a foot where the toes of the foot join the foot (fig 4, element 26), a chassis supporting at least four wheels including a front wheel and a second wheel immediately behind said front wheel, said front wheel and said second wheel being located in a front zone of said chassis (fig 1), at least first (fig 4, element 27) and second binding points on the sole attaching for attachment of the sole to the chassis (fig 4, element 27), the first binding point being positioned in proximity of the heel-piece zone of the sole (fig 4, element 27), and the second binding point being positioned approximately in the a-toe

junction area of said sole (fig 4, elements 27 and 28), fasteners for joining the footwear to the chassis at the first and second binding points (fig 4, elements 22,24 and 29), the second binding point being located between the front wheel and the second wheel (fig 4, element 27), and wherein a center to center distance between said first and second binding points is between 170 mm and 210 mm (col 3, paragraph 0045 states that each boot size should receive a frame size corresponding perfectly thereto regardless of the size or the sizing standard used). Borel lacks the teaching of at least four wheels having a diameter of at least 100 mm. Hilgarth discloses wheels having a diameter of between 90mm-120mm in column 7, lines 37-40. Based on the teaching of Hilgarth, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate of Borel to use wheels with at least 100mm diameter as in Hilgarth so as to allow the user to maintain substantially optimum skating conditions. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claim 7, the skate of modified Borel or Hilgarth discloses wherein the center to center distance between the first and second binding points is 195 mm (Borel, column 1, paragraph 0007) states that the center distance is not constant and varies from about 140mm-210mm.

Response to Arguments

The declarations under 37 CFR 1.132 filed January 30, 2008 are insufficient to overcome the rejection of claims 5 and 7 based upon unexpected results, commercial success and copying as set forth in the last Office action because applicant has not made a persuasive showing required under 37 C.F.R. 1.132 for the reasons discussed below.

1. Unexpected results – MPEP 716.02(a)-(g)

- Difference should be “in kind” not “in degree”
- Showing must be commensurate in scope with the invention **as claimed**
 - Need Test Data and analysis: **direct comparison** of the claimed invention **with the closest prior art** which is **commensurate in scope with the claims**.
 - Actual steps carried out, the materials employed, and the results
 - Nothing concerning the work relied upon should be left to conjecture.
 - Statement that “the prior art invention did not perform well” without a showing of the actual results of the test performed on the prior art AND on the claimed invention is insufficient.
 - Results must be due to the **claimed** features, not to **unclaimed** features
- The burden is on the applicant to establish that the results are in fact unexpected, unobvious, and of statistical and practical significance.

2. Commercial Success – MPEP 716.03(a)-(b)

- Must establish a **nexus** between the claimed features of the invention and the commercial success
 - Success must be linked to the claimed invention and not to some extraneous factor (e.g., advertising; brand name recognition; market share)
 - Merely showing that there was commercial success of an article which embodied the invention is not sufficient.
- Showing must include **at least**:
 - A description of what was sold. What was sold must include the features of invention **as claimed**.
 - A description of the relevant market for the product including advertising.
 - Sales results.
 - Total sales for competing products in the market
 - Indicate differences between these products and the applicant's product sold
 - Total sales for products embodying the invention

- Pricing of the various products.
- Gross sales figures do not show commercial success absent evidence as to market share.
- Inventor's opinion as to the purchaser's reason for buying the product, alone, is insufficient to demonstrate a nexus between the sales and the claimed invention.

3. Copying – MPEP 716.06

- Showing must be more than the mere fact of copying.
- Copying must not be attributable to other factors such as:
 - lack of concern for patent property
 - contempt for patentees ability to enforce patent
- Evidence of copying may be persuasive when there is a showing that alleged infringer(s) tried for a substantial length of time to design a product similar to the claimed invention, but failed and then copied the invention instead.

Regarding the insufficiency of the Prandina declaration, the following observations have been made by the examiner.

- Applicant provided in exhibit A sales comparison of the 80/84 and big wheel, however the data fails to show that the drop of sales was attributable to the claimed big wheel skate and not to other factors such as failure to provide the 80/84 skate for sale, cost of skate or advertising budget. See showing required for commercial success discussed above.
- Applicant has provided in exhibits C-L as evidence of copying by competitors and possibly commercial success. This evidence is insufficient because it fails to provide a nexus between the claimed of the invention and the commercial success. It is unclear from the evidence provided and statements made whether the claimed skate is in fact the skate that "won almost all the races." The evidence shows that the 84mm/82A skate was part of the competitions and could have won some of the races. Furthermore it is pure speculation that the skate design caused FILA to win the races and not the athletes themselves. There is

nothing in the evidence showing the skate being claimed is the skate the competitors are copying. Since applicants have only provided the names of the competition skates and not product design specifications the examiner cannot determine whether these skates are copies of the claimed invention.

- Regarding exhibit M this appears to be evidence of unexpected results. The evidence is insufficient because applicant has failed to provide the actual steps carried out and the materials employed. Everything regarding how the results were obtained has been left to conjecture by the examiner.
- Regarding the insufficiencies of exhibits B1 and B2, they have not been provided in English and therefore cannot be evaluated without a certified translation.

Regarding the insufficiency of the Lazzari declaration, the following observations have been made by the examiner.

- Declarant is an employee of the assignee of the invention and therefore is not a disinterested person of ordinary skill in the art.
- The legal determination of obviousness is a factual inquiry made by the examiner and not persons of skill in the art.
- The declaration has been submitted into evidence but is insufficient to overcome the examiners finding of obviousness.

Regarding applicants request for reconsideration, the examiner regrets failing to provide the above reasons for the declarations being insufficient in the previous office action as discussed in the interview.

Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

(A) Ascertaining the differences between the claimed invention and the prior art; and

(B) Ascertaining the differences between the claimed invention and the prior art; and

(C) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. Such evidence, sometimes referred to as "secondary considerations," may include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results. The evidence may be included in the specification as filed, accompany the application on filing, or be provided in a timely manner at some other point during the prosecution. The weight to be given any objective evidence is made on a case-by-case basis. The mere fact that an applicant has presented evidence does not mean that the evidence is dispositive of the issue of obviousness.

The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the Graham factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis. The Graham factors were reaffirmed and relied upon by the Supreme Court in its consideration and determination of obviousness in the fact situation presented in *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391 (2007). The Supreme Court has utilized the Graham factors in each of its obviousness decisions since *Graham*. See *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 189 USPQ 449, reh 'g

denied, 426 U.S. 955 (1976); Dann v. Johnston, 425 U.S. 219, 189 USPQ 257 (1976); and

Anderson 's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 163 USPQ 673 (1969). As stated by the Supreme Court in KSR, "While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls."KSR, 550 U.S. at ___, 82 USPQ2d at 1391. see MPEP 2141.

B. Simple Substitution of One Known Element for Another To Obtain Predictable Results

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
- (2) a finding that the substituted components and their functions were known in the art;
- (3) a finding that one of ordinary skill in the art could have substituted one known Element for another and the results of the substitution would have been Predictable; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

As set forth in the rejection Borel teaches all of the claimed elements except for the claimed wheels having the diameter of at least 100mm.

Hilgarth teaches wheels having a diameter of 90mm and 120mm advantageously between 100mm and 110mm (col. 7, lines 38-40). Hilgarth further teaches that for purposes of his patent the terms roller skate and skate with aligned wheels must be understood in the widest sense of the words and therefore including all kinds of embodiments of footwear suitable for skating or sliding on any kind of surface (col. 1, lines 7-14).

Based on these facts a person of ordinary could have substituted one known element for another and the results of the substitution would have been predictable regarding optimization of any performance characteristics of the skate including shock absorption, comfort and stability. Applicant's evidence of secondary consideration to overcome the examiners finding that the results of the combination would have been unpredictable to a person of ordinary skill in the art are unconvincing for the reasons stated above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CYNTHIA F. COLLADO whose telephone number is (571)272-8315. The examiner can normally be reached on mon-fri 6-2.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571)2726914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CFC
/Cynthia F Collado/
Examiner, Art Unit 3618

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Training Quality Assurance Specialist, TC 3600